

REMARKS

The application has been amended and is believed to be in condition for allowance.

The previously pending claims have been canceled and replaced with new claims which read on the elected species II comprising a plug with a rod-like element that retains the edible. Attention is directed specifically to Figures 31-34 as well as the generic figures of the invention.

The previously pending claims were rejected as indefinite. The formal criticisms of those claims have been considered and replacing the previously pending claims with the new claim set. Accordingly, withdrawal of the indefiniteness rejection is solicited.

The previously pending claims were rejected as obvious over LANDAU S.N. 08/797,593 in view of HARVEY et al. '737, CECERE '899, COLEMAN '527, LUZENBERG '012, NOHREN '416 AND CHAMBERS '925.

Dependent claims 31, 32, and 37 were rejected in further view of GALLART et al. '407.

The newly presented claims are believed patentable as the cited prior art references, taken alone or in any reasonable combination thereof, do not teach or suggest the combination of features as now recited by either independent claims 38 and 53. Further, the dependent claims are believed allowable at least for depending from an allowable independent claim. Additionally,

features of the dependent claims are believed to be novel and non-obvious over the prior art, either alone, or in combination with the claims from which these dependent claims depend.

Accordingly, reconsideration and allowance of the pending claims are respectfully requested.

The invention, as recited, is directed to a beverage plug for sucking a beverage allowing the user to efficiently and progressively transfer the taste and nutritional components of a food product (praline) to a beverage being sucked. At the same time, the user may lick the praline in a manner controlled and favored by rubbing the user's tongue thereon or the user's lips thereon.

Advantageously, the profiled curved rim of the top portion of the plug promotes this operative use of the inventive plug.

Specific comments concerning the prior art references follow:

As stated in LANDAU on page 4, lines 22-24, LANDAU notices that: "A need therefore exists in the (straw-based) prior art for a device and method of flavoring fluid in bottles that are covered by restricted caps." LANDAU solves this need starting from the prior art illustrated in Figures 1 and 2 and by disclosing the following embodiments:

Figure 2, first embodiment. As correctly stated by the Examiner, the proposed cap (plug) has a base or fixing portion, a

middle portion, and a top portion (e.g., 54, 56 and 84). However, in this embodiment, the top portion 54 is not made from plastics (as previously known in the prior art) but it is made from a consumable material 56 that dissolves either in water or in saliva. In other words, said top portion is made by a praline or candy, which would mainly dissolve as the fluid passes through the internal central candy hole. The fluid cannot flow on the candy external surface. The user's lips can only directly lean against the candy outside, which obviously disturbs the free access of the user's tongue to the candy, that is the free licking of the latter when the lips are placed on the candy external surface.

On the contrary, in applicant's invention, the user's lips lean against the plug top portion bordered by a rim (as indicated by C in Figure 2), wherein the fluid flows around the candy outside and the user's tongue can freely lick the candy (which latter does not need any internal hole or conduits).

Figure 3, second embodiment. The cap element 62 is made from two separate materials, that is the central plastic element 62 and the exterior coating of consumable material or candy 66. The appreciation is the same as set forth for the embodiment of Figure 2. However, the candy dissolving is slower due to the fact that the fluid can only flow around the candy outside in the user's mouth.

Figure 4, third embodiment. In is similar to the first embodiment of Figure 2. The only difference is that the candy 72 is shaped and/or colored to provide an indication of the flavor thereof. In the shown embodiment, an apple shape is illustrated indicating an apple taste.

Figure 5, fourth embodiment. In this embodiment the candy 82 is located inside the plug neck 86 in order to obstruct the interior of said neck 86. In order to enable fluid to pass through the candy 82 the latter is perimetrically provided with conduits 89. It is obvious that both the user's lips and tongue have no access to the candy.

Figure 6, fifth embodiment. The consumable material or candy is not directly part of the plug. A straw 95 is provided which, as known in the prior art, adds flavoring to fluid passing through said straw. The straw 95 is supported by a straw receiving element 92 housed into the plug 90. Also, in this embodiment the candy is not accessible to the user's lips and tongue.

Figure 7, sixth embodiment. The novelty of this embodiment is that the plug bottom portion 104 and/or the cap top portion 102 are molded from a plastic impregnated with a fragrance, such as lemon, orange or the like. The person drinking from the bottle plug 100 would smell the fragrance as he/she drank.

Figures 8, 9 and 10, further embodiments. In the embodiment of Figure 8 the cup lid 200 is made from a fragrance impregnated plastic. In the baby's bottle cap 300 shown in Figure 9 either the nipple and/or the annular cap 304 are molded from a fragrance impregnated plastic. The bottle shield 400 of the bottle shown in Figure 10 is made from fragrance impregnated plastic.

In LANDAU there are no indications or suggestions to place the flavoring component inside the plug in such a manner that the fluid can flow around the external candy surface and at the same time the user's tongue has a free and direct access to the candy. Only these features allow the new kind of beverage sucking as disclosed in the present application and recited in the new claims, i.e., claim 38.

Consider next the disclosure of HARVEY.

Figures 1 and 2, first embodiment. Shown is a mouthpiece 1 supporting at one end a straw 2 and at the other end a tip 3 having a coating 8 comprising a miraculin composition (equivalent to a candy). The mouthpiece 1 is provided with radial passages 7 which communicate between the outside surface of the mouthpiece 1 and the straw interior through a lengthwise channel 4 in said mouthpiece 1. No plug is provided. Only a simple removable cover 11 covers the candy 8. The mouthpiece 1 is not designed as a plug and with the shown design it is only provided for being housed, together with a straw 2, into a can 28, where

said mouthpiece 1 does not act at all as a plug and receives the fluid from inside the straw 2 and the lengthwise passageway 4 and the radial passageways 7 into the user's mouth. The mouthpiece 1 is hollow. It cannot be solid as in the present application.

In fact, in the present application the candy P is supported on a solid pin-like peg 34 or 34A, wherein the fluid flows outside the peg 34 or 34A between said peg 34, 34A and the internal wall of the plug and wherein the fluid coming from the bottle inner flows through openings formed by radial arms 33, said arms 33, peg 34 or 34A and the plug body forming a one-piece plug.

Figure 3, second embodiment. In this embodiment, the mouthpiece 14 has a tubular conformation with one end 15 housing a straw 16 and the other end 17 being closed by a removable seal 18 fitted therein and integrally formed in a removable cover 19. By providing a tapered mouthpiece 14 a space 22 is obtained between the cover 19 and the mouthpiece 14 so that the tapered portion of the latter can be coated with a miraculin coating 23. When the cover 19 is removed during use the user's tongue can contact said miraculin coating 23, wherein also in this embodiment said mouthpiece 14 must be hollow in order to enable the fluid to exit the latter. Also, in this embodiment there is not provided a flowing space between the miraculin coating 23 and a bottle fixed plug where the fluid should flow around the miraculin coating 23. In HARVEY, there are no indications or

suggestions that similar mouthpieces could be housed in a bottle plug instead of in a can as taught in this reference.

In COLEMAN, a cap 24 of a squeezable reservoir 18 supports by means of a hollow stick 26 a candy 28 having throughgoing channels 30. The whole candy 28 is supported outside the cap 24 and it may only be licked like a traditional lollipop. Said candy 28 which wholly projects from the cap cannot be lapped outside upwards from the beverage and cannot enable the positioning of the user's lips on the cap in order to permit the new kind of sucking a beverage from the reservoir or bottle as in the present application.

The several shown LUZENBERG embodiments that have the common feature that in a bottle cap provided with a manual valve or a "pop-up" dispensing closure is housed a porous plastic article 10, 20, 90 for dispensing flavoring materials, coloring materials, medicines, caffeine and the like into a beverage. Said plastic articles 10, 20, 90 have an internal longitudinal recess 15 through which the beverage may pass in contact with the exposed internal surface of said articles 10, 20, 90.

As inferable from Figures 2, 3 and 9, said articles 10, 20, 90 are completely housed inside the cap 50, 80 and the bottle 40 so that there is no possibility for the user's tongue to lick said articles 10, 20, 90 as well as for the beverage to flow around and along the outside of the articles 10, 20, 90.

As shown in NOHREN Figure 3 the filter element 10 (comprising a carbon block filter 11, a material to be dispersed 12 and an optional inner membrane 13) is fitted to a plastic cap 22 having a conventional push-pull valve 23. Also, in the shown embodiments a direct contact between the user's tongue and the dissolvable material to be dispersed (candy) is not allowed.

The CHAMBERS hollow globe-like container attachment 10 for pop bottles 16 contains flavoring mixtures, ice cream fizz syrups and the like and has a first neck 14 to be inserted into a bottle neck 15 as well as a second or drinking neck 17. When drinking, the ice cream, mixture or the like (candy) placed in the container 10 will impregnate the beverage flowing from the bottle inside on said ice cream, mixture or the like before entering in the user's mouth. Also, in this reference, there is no possibility for the drinking person to lick the flavoring material inside said globe-like container 10.

As clearly inferable from the GALLART Figures 2, 5, and 6, the candy mass 14 is supported on the projection 28 which integrally projects from the base component 16 and not from a (non-existing) plug. The cover 18 has only an anti-dust function. The shown confectionary product and the interior compartment 22 thereof is not provided for containing a beverage.

One skilled in the art would not combine LANDAU with HARVEY or the other references for obtaining the new kind of drinking a beverage added with a flavor as disclosed in the



present application because the design features suggested in the present application are not evident in the mentioned references and the latter are silent on such suggestions.

There must be motivation for combining the prior art references rather than a mere hindsight cherry picking of the prior art references. Using the present application as a blueprint to locate prior art references which would, if combined, include the features of the recited invention is impermissible. The CFC has made clear that such an approach is invalid.

Relevant to this point, the Federal Circuit emphasized in July, 1998 that "[m]ost, if not all, inventions are combinations and mostly of old elements." *In re Rouffett*, 47 USPQ 2d 1453, 1457 citing to *Richdel, Inc. v. Sunspool Corp.*, 219 USPQ 8, 12 (Fed. Cir. 1983). The Federal Circuit continued by noting that "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blue print for piecing together elements in the prior art to defeat the patentability of the claimed invention."

Thus, the Federal Circuit requires that in order to prevent the use of such hindsight, the Official Action must "show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art

references for combination in the manner claimed." (*In re Rouffett* at 1458).

Further, as stated by MPEP §706.02(j), to establish a *prima facie* case of obviousness the Official Action must first, consider the relevant teachings of the prior art, and after determining the differences between the pending claim and the prior art teachings, second, propose modifications of the prior art necessary to arrive at the claimed subject matter, explaining the motivation for combining the particular references and making the proposed modifications to those references. Thus, there must be motivation to modify the references and a teaching or suggestion of **all** the claim recitations.

As noted above, the claims' recitations are neither taught nor suggested by the applied references. Only the present application offers the recited disclosure, and it is well established that the teaching or suggestion to make the claimed combination and the reasonable expectation of success therein must both be found in the prior art, and not be based on the present disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further, the prior art references must either expressly or impliedly suggest the claimed invention or the Official Action must convincingly reason why one skill in the art would have found the claimed invention obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

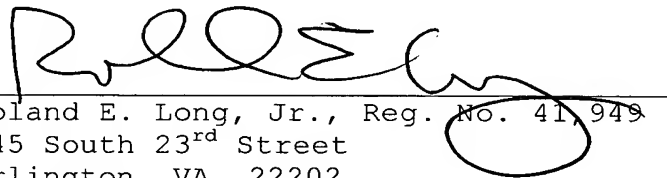
In the present situation, there is no teaching or suggestion available to provide the requisite motivation, suggest the necessary modifications, or provide the reasonable expectation of success. Thus, the obviousness rejection is not believed to be viable.

Therefore, reconsideration and allowance of all the pending claims are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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